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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053237
Party	Plaintiff Barnhardt Manufacturing Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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BARNHARDT MANUFACTURING )  
COMPANY )

Petitioner, )

Cancellation No: 92053237

WILDWOOD GIN, INC. )

Registrant. )  
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**PETITIONER'S TRIAL BRIEF**

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Pursuant to Trademark Rule 37 C.F.R. § 2.128(a), Petitioner, Barnhardt Manufacturing Company (“Barnhardt”) submits its Brief on the Merits as follows:

### **Introduction**

This case involves a situation where two competitors in a close-knit industry both picked the same mark for nearly identical and competing products. There is no doubt that confusion will occur and there is no doubt that only one of these competitors can continue to use the mark. In this particular case, Barnhardt is the senior user and has priority rights. Thus, Wildwood’s registration should be cancelled.

Barnhardt owns the mark ULTRA-CLEAN and uses the mark in connection with bleached cotton. The ULTRA-CLEAN mark has been used throughout the United States and internationally, continuously, since at least as early as March of 2006 and is well-known throughout the cotton nonwovens industry. Barnhardt has priority rights in the mark ULTRA-CLEAN dating back to early 2006 and is undisputedly the senior user.

Registrant, Wildwood Gin, Inc. (“Wildwood”) is the owner of U.S. Trademark Registration No. 3,670,482 for the mark ULTRACLEAN which is the subject of this Cancellation Proceeding No. 92053237. Wildwood’s ULTRACLEAN mark is used in connection with raw cotton in International Class 022. Registration No. 3,670,482 for the mark ULTRACLEAN was filed on May 9, 2008, registered on August 18, 2009, and cites a first use date of June 2, 2008.

Barnhardt is also the owner of the application, Serial No. 85/072,021 for the mark ULTRA-CLEAN which has been denied on the basis of Wildwood’s ULTRACLEAN registration.

There is no doubt that the marks ULTRA-CLEAN and ULTRACLEAN, both for cotton in the nonwovens industry, will cause consumer confusion. It is difficult to imagine a more clear-cut case of likelihood of consumer confusion than the present one where the marks are virtually indistinguishable, the goods are nearly identical, and the channels of trade are exactly the same. Accordingly, Barnhardt requests that the Board cancel the registration of Wildwood's ULTRACLEAN mark, Reg. No. 3,670,482

### **Summary of Legal Argument**

Petitioner Barnhardt seeks to cancel the ULTRACLEAN mark, U.S. Registration No. 3,670,482, owned by Wildwood. Barnhardt filed a Petition to Cancel the ULTRACLEAN registration on the basis of Barnhardt's priority rights in the mark ULTRA-CLEAN and the likelihood of confusion with Barnhardt's ULTRA-CLEAN mark.

Barnhardt started using the ULTRA-CLEAN mark in connection with a bleached cotton product in early 2006. Years later, in May of 2008, Wildwood filed an intent-to-use application for the mark ULTRACLEAN for use in connection with raw cotton. Wildwood's undisputed date of first use is June 2, 2008, more than two years after Barnhardt began using the ULTRA-CLEAN mark. *Deposition of Lawson Gary, Page 16:Lines 12-19 (July 15, 2011.)* Barnhardt eventually learned of Wildwood's use of the ULTRACLEAN mark and filed the Petition to Cancel in this matter.

Consistent with legal precedent, the issue in this Cancellation is whether Wildwood's registration for ULTRACLEAN will create a likelihood of consumer confusion as to the source of origin of the goods or confusion that the goods are somehow associated with or sponsored by the same entity in comparison to Barnhardt's ULTRA-CLEAN mark. Barnhardt submits that based on its continuous and prior use of the ULTRA-CLEAN mark, Wildwood's use of the

ULTRACLEAN mark should be cancelled as it is likely to cause confusion, mistake or deception.

The marks at issue, ULTRACLEAN and ULTRA-CLEAN, are exact phonetic equivalents, nearly identical visual equivalents, used in connection with almost the same product, by competitors in the same industry and same channels of trade. There will undoubtedly be confusion if Wildwood is allowed to maintain its federal registration for the ULTRACLEAN mark. Further, Barnhardt will be injured by the confusion with its own ULTRA-CLEAN mark that has been in use for several years longer than Wildwood's mark and Barnhardt will be deprived of the right to federally register the ULTRA-CLEAN mark. Consequently, Barnhardt is requesting that the Board cancel Wildwood's ULTRACLEAN registration which would then allow Barnhardt's application for ULTRA-CLEAN to proceed to registration.

### **Standing**

Barnhardt has standing on the basis of the ownership of priority common law rights in the ULTRA-CLEAN mark since 2006. The Lanham Act confirms standing under 15 U.S.C. § 1064, which provides:

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believed that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by the Act, . . . within five years from the date of the registration of the mark under this Act.

Further, 37 C.F.R. § 2.111(b) states that any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads



(and later proves) a claim of likelihood of confusion that is not wholly without merit. *See Lipton Industries, supra; Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 U.S.P.Q.2d 1205, 1209 (T.T.A.B. 1993). Also, a real interest in the proceeding and a reasonable belief of damage may be found if plaintiff pleads that plaintiff has been refused registration of its mark because of defendant's registration, or has been advised that it will be refused registration when defendant's application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant's registration. *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 U.S.P.Q.2d 1298, 1300 (T.T.A.B. 2000)

In the case at hand, Barnhardt has been damaged and will continue to be damaged if the registration of Wildwood's ULTRACLEAN mark is maintained because it will infringe and cause consumer confusion as to the origin of products offered under Barnhardt's ULTRA-CLEAN mark. Barnhardt has been and will continue to be further damaged by the inability to federally register its own ULTRA-CLEAN mark.

Barnhardt bases the present cancellation proceeding on a reasonable belief of damage; the fact that Barnhardt's ULTRA-CLEAN mark and Wildwood's ULTRACLEAN mark are so similar as to cause consumer confusion; Barnhardt's priority common law rights in the mark ULTRA-CLEAN; and the refusal by the Trademark Office to register Barnhardt's ULTRA-CLEAN mark based on a likelihood of confusion with Wildwood's ULTRACLEAN registration.

Based on the foregoing, Barnhardt believes that it has satisfied the liberal standing requirement for petitioning to cancel Wildwood's trademark registration.

#### **Description of the Record**

Barnhardt has made the items of record in its Notice of Reliance, dated November 8, 2011, and served upon Wildwood's attorney. Specifically, Barnhardt relies upon the following

items of record:

- The testimony deposition of Lewis Barnhardt and all corresponding exhibits;
- The 30(b)(6) deposition of Wildwood by Lawson Gary and all corresponding exhibits;
- Wildwood's Response to Barnhardt Manufacturing's First Set of Interrogatories;
- Barnhardt's Petition to Cancel in this matter;
- USPTO record and file history of Barnhardt's federal application for the mark ULTRA-CLEAN, Serial No. 85/072,021; and
- USPTO records for Barnhardt's active and non-active applications and registrations for the marks ULTRAWHITE, ULTRASORB, ULTRASCENT, ULTRAWHITE SOFT, ULTRAWHITE PURE, ULTRASORBENT, and ULTRABLOCK.

Wildwood also filed a Notice of Reliance, dated December 7, 2011, in which it made of record the following items:

- Barnhardt's Response to Wildwood's First Set of Interrogatories;
- Barnhardt's Response to Wildwood's First Request for Admission; and
- Barnhardt's testimonial deposition of Lewis Barnhardt.

It should be noted that Wildwood produced very little discovery, took no discovery depositions, and no testimonial depositions. Thus far, Wildwood has not put forth any evidence to dispute Barnhardt's senior use of the ULTRA-CLEAN mark or the obvious likelihood of confusion between ULTRA-CLEAN and ULTRACLEAN.

#### **Statement of the Facts**

Barnhardt sells and offers for sale bleached cotton in connection with its ULTRA-CLEAN trademark across the United States and internationally. *Deposition of Lewis Barnhardt, 21:Lines 18-24. (October 25, 2011)* The trademark ULTRA-CLEAN has been in use in

commerce in connection with bleached cotton continuously since at least as early as March of 2006. *Barnhardt Dep. 19:6-14*. The cotton product sold in connection with the ULTRA-CLEAN mark is sold in the very narrow nonwovens industry. *Barnhardt Dep. 5:7-13; 6:18-25*.

Wildwood filed an intent-to-use application for ULTRACLEAN on May 9, 2008 and obtained the registration on August 18, 2009, claiming a date of first use of June 2, 2008. Wildwood offers its raw cotton ULTRACLEAN product to the same nonwovens industry for use in the exact same end products and even to some of the same clients as Barnhardt.<sup>1</sup> *Barnhardt Dep. 22:16-25; Gary Dep. 13:20-22; 22:25; 23:1-3; 30:9-12*.

Barnhardt has a long history of using the ULTRA prefix for marks used in association with cotton products. Barnhardt first started using the ULTRA prefixed marks back in the early 1990's with the mark ULTRAWHITE used in association with cotton. *Barnhardt Dep. 7:7-22; 8:5-15; Barnhardt Dep. Exhibit 1*. The ULTRAWHITE mark has been used continuously in commerce since at least as early as 1994 and is an active federally registered mark, Registration No. 1,893,824. *Barnhardt Dep. Exhibit 1*. Since then, Barnhardt has used the ULTRA prefix on several marks such as ULTRAWHITE, ULTRASORB, ULTRASCENT, ULTRA WHITE SOFT, ULTRA WHITE PURE, ULTRASORBENT, ULTRABLOCK and, the subject of this proceeding, ULTRA-CLEAN. *Barnhardt Dep. 8:23-25; 9:1-6; Gary Dep. Exhibits 2, 6, 7, 8, 9*. Barnhardt is well-known in the close-knit industry of nonwovens as being the owner of the ULTRA prefixed marks.

Barnhardt and Wildwood are competitors, with the same target market, who attend the same trade shows, and advertise in the same industry publications. *Barnhardt Dep. 13:2-11*.

The ULTRA-CLEAN and ULTRACLEAN products are sold to the same type of and actual

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<sup>1</sup> Wildwood is the trademark owner and producer of the ULTRACLEAN product. However, T.J. Beall is the exclusive marketer and supplier of all of Wildwood's cotton products. *Gary Dep. 7:6-9*. Thus, for purposes of this action, Wildwood and T.J. Beall are collectively referred to as Wildwood.

purchasers for use in the same end products. *Gary Dep.* 22:19-25; 23:1-3. *Barnhardt Dep.* 23:1-12.

Upon seeing an advertisement for Wildwood's ULTRACLEAN product in an industry publication, Barnhardt, knowing it had priority rights in its ULTRA-CLEAN mark, filed an application to register the ULTRA-CLEAN mark. *Barnhardt Dep.* 20:8-20. Barnhardt also filed the present Petition to Cancel.

### **Legal Argument**

#### **A. Priority Rights: Barnhardt is the senior user.**

The underlying right to use a trademark is established by prior use, or "the one who first uses the marks in connection with a peculiar line of business." *See Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 815 (1<sup>st</sup> Cir. 1987) *citing Blanchard Importing & Distrib. Co. V. Charles Gilman & Son, Inc.*, 353 F.2d 400, 401 (1<sup>st</sup> Cir. 1965).

In order to establish priority, a party must demonstrate it made trademark use of its mark in connection with an ongoing commercial trade on its goods or trademark use before the other party. *Shalom Children's Wear v. In-Wear A/S*, 26 U.S.P.Q. 2d 1516, 1519 (T.T.A.B. 1993). Prior use in commerce, prior registration, prior trademark use, prior use as a trade name, or prior use analogous to trademark use is sufficient to establish priority. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F. 3d 1156, 1162 (Fed. Cir 2002).

Wildwood obtained the registration for ULTRACLEAN on August 18, 2009, claiming a date of first use of June 2, 2008 in connection with raw cotton. Barnhardt has used the ULTRA-CLEAN mark continuously since at least as early as March of 2006. *Barnhardt Dep.* 19:6-14. Barnhardt has internal emails discussing the ULTRA-CLEAN product from late 2005, as well as invoices sent to consumers showing the ULTRA-CLEAN mark dated in 2006. *Barnhardt Dep.*,

16:1-25; 17:1-4; *Barnhardt Dep. Exhibits 4, 5, and 6*. In addition, Barnhardt was clearly marking each cotton bale with a bale label showing the mark ULTRA-CLEAN on the product. *Barnhardt Dep. Exhibit 6*. Barnhardt has invoices, held in the customary course of business records, showing completed sales of the ULTRA-CLEAN cotton product prior to Wildwood's undisputed first use of June 2, 2008.<sup>2</sup> *Barnhardt Dep. 17:19-25; 18:1-25; 19:1-14; 20:3-7*. Additionally, Mr. Barnhardt has testified that ULTRA-CLEAN was used on the product packaging since March of 2006. *Barnhardt Dep. 17:19-25; 18:1-25; 19:1-14; 20:3-7*.

Based on the overwhelming evidence, Barnhardt's ULTRA-CLEAN mark was in use in commerce prior to Wildwood's first use of its ULTRACLEAN mark. There is no doubt that Barnhardt is the senior user and Barnhardt's priority use of the mark ULTRA-CLEAN has been undisputed in this proceeding thus far.

**B. Likelihood of Confusion: ULTRA-CLEAN and ULTRACLEAN have a strong likelihood of confusion.**

Cancellation is proper because Barnhardt has priority of use and consumers are likely to be confused as to the origin of Wildwood's goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000) ("One such ground [for cancellation] is Section 2(d) of the Lanham Act, relating to a likelihood of confusion between the mark sought to be canceled and a mark for which the party seeking cancellation can establish either prior use or prior registration."). Barnhardt has valid, subsisting common law rights that predate Wildwood's intent-to-use application filing date. Thus, Barnhardt has priority rights to exclude others from use of marks that are confusingly similar to the ULTRA-CLEAN mark.

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<sup>2</sup> Barnhardt produced these invoices to Wildwood on April 8, 2011 as bates numbers BAR 000023-000026.

Wildwood's ULTRACLEAN mark so resembles Barnhardt's ULTRA-CLEAN mark "as to be likely, when used in connection with the goods of the Registrant, to cause confusion, or to cause mistake or to deceive." 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion under Section 2(d) of the Trademark Act, Courts and the PTO consider the thirteen factors enumerated in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). No one of the thirteen factors is more important than the others and "each may from case to case play a dominant role." *Id* at 567. The Applicant submits an examination of the following relevant *duPont* factors reveals that no likelihood of confusion exists between the marks in question:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue channels of trade;
- (5) The fame of the prior mark;
- (6) The number and nature of similar marks in use on similar goods;
- (7) The nature and extent of any actual confusion;
- (9) The variety of goods on which a mark is or is not used;
- (10) The market interface between the applicant and the owner of a prior mark;
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; and
- (13) Any other established fact probative of the effect of use.

*duPont*, 177 U.S.P.Q. 567.

It must be kept in mind that when applying the facts to the law in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1408; (Fed. Cir. 1997); *Federated Foods, Inc. v. Gort Howard Paper Co.*, 544 F.2d 1098, 1101 (C.C.P.A. 1976).

A review of the *duPont* factors shows that a strong likelihood of confusion exists and, as such, this Board should cancel Wildwood's registration of the ULTRACLEAN mark.

**1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.**

The first relevant *duPont* factor concerns the similarity of the actual marks in question. The standard for determining the similarity of marks involves evaluating the similarities in sight, sound and meaning. *In re Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988). In a particular case, any one of these means of comparison may be critical in finding the marks are similar. *Id.*

The marks in this case are nearly identical: ULTRA-CLEAN versus ULTRACLEAN. The marks are visually almost identical. The *only* difference is the hyphen in Barnhardt's ULTRA-CLEAN mark whereas Wildwood's ULTRACLEAN does not have a hyphen. The marks are phonetically identical and give the same commercial impression. *See Universal Tech v. Jillson & Roberts, Inc.*, (T.T.A.B. 1997) (finding a likelihood of confusion because ZIPWRAP and ZIP-WRAP were virtually the same in appearance, identical in sound, connotation and overall impression).

The similarities in the marks speak for themselves. One would be hard pressed to come up with any rational argument that ULTRACLEAN and ULTRA-CLEAN are not virtually identical in appearance, sound, connotation and commercial impression. This factor weighs heavily in favor of a likelihood of confusion and in favor of cancellation.

**2. The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use.**

The second *duPont* factor relevant to the present case is the "similarity or dissimilarity of the nature of the goods described in an application or registration or in connection with the prior mark in use." *duPont*, 476 F.2d at 1361. The goods of the parties need not be identical or

directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Industries, Inc.*, 518 F.2d 1399, 1404 (C.C.P.A. 1973), TMEP § 1207.01(a) (i). Rather they need only be related in some manner or the conditions surrounding their marketing are such that they would be encountered by the same purchasers, under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 52 U.S.P.Q.2d 1474, 1476 (T.T.A.B. 1999). Additionally, the greater the degree of similarity between the marks, the lesser the degree of similarity between the goods required to support a likelihood of confusion.

In the present case, the ULTRA-CLEAN and ULTRACLEAN products are very similar to each other. They are both for cotton in International Class 022. These similar products are alternatives to one another for use in the very same end products. *Barnhardt Dep. 13: 2-11; 23:1-12; Gary Dep. 20:19-25; 21:1-7; 30:5-12*. The only difference is that Wildwood's ULTRACLEAN is mechanically cleaned while Barnhardt's ULTRA-CLEAN is cleaned with bleach. *Barnhardt Dep. 12:5-22*. Only those in the nonwovens industry are likely to even know the difference between the products. Both the ULTRACLEAN and ULTRA-CLEAN products are used as a constituent part of end products for the medical and feminine hygiene markets. *Barnhardt Dep. 23:1-12; Gary Dep. 30:5-12*.

It is difficult to imagine an argument that cotton is different from cotton, even if you get into the minutia of how each cotton product is processed. *See In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531, 1532 (T.T.A.B. 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade and be sold to the same class of purchasers."). There is simply no rational argument that the goods are not similar. This factor also weighs heavily in finding a likelihood of confusion.



**3. The similarity or dissimilarity of established, likely-to-continue channels of trade.**

The channels of trade are exactly the same. Barnhardt and Wildwood are admittedly competitors who admittedly sell to the same type of and, even more troubling, some of the exact same purchasers. *Barnhardt Dep. 13:2-11; 22:6-25; 23:1-12. Gary Dep. 22:17-25; 23:1-3 and 17-19.* The nonwovens industry is a relatively narrow industry with only two or three competitors. *Barnhardt Dep. 6:18-25.* Barnhardt and Wildwood both attend the same trade shows and they both advertise their products in the same industry publications. *Gary Dep. 26:1-25; 30:1-12.* The ULTRA-CLEAN and ULTRACLEAN products are both materials for use in the same end products. *Gary Dep. 30:5-12.*

The channels of trade for Barnhardt and Wildwood aren't just similar, they are exactly the same. Barnhardt and Wildwood are direct competitors. This factor also weighs heavily in favor of likelihood of confusion.

**5. The fame of the prior mark**

Barnhardt is well-known in the nonwovens industry to be the owner of the ULTRA prefixed trademarks that Barnhardt first started using in the early 1990s. *Barnhardt Dep. 7:7-22; 8:1-25; 9:1-6.* Barnhardt has, over the years, used at least eight trademarks with the prefix ULTRA. *Gary Dep. Exhibits 6-9.* All of these marks have at some point been the subject of a federal trademark application or registration. *See USPTO records for ULTRAWHITE Serial No. 74/385,643, ULTRASORB Serial No. 78/048,640, ULTRASCENT Serial No. 78/048,637, ULTRAWHITE SOFT Serial No. 74/385,645, ULTRAWHITE PURE Serial No. 74/385,644, ULTRASORBENT Serial No. 78/048,641 and ULTRABLOCK Serial No. 75/471,846.*

The only ULTRA prefixed mark that has been and continues to be an active federal registration is the mark ULTRAWHITE. *Barnhardt Dep. Exhibit 1.* Barnhardt's

ULTRAWHITE mark has been in continuous use since at least as early as 1994 and is an active federally registered mark today. *Barnhardt Dep. Exhibit 1*. While the other ULTRA applications and registrations have been allowed to lapse, many of these ULTRA marks were used by Barnhardt for many years. *See USPTO records for ULTRAWHITE Serial No. 74/385,643, ULTRASORB Serial No. 78/048,640, ULTRASCENT Serial No. 78/048,637, ULTRAWHITE SOFT Serial No. 74/385,645, ULTRAWHITE PURE Serial No. 74/385,644, ULTRASORBENT Serial No. 78/048,641 and ULTRABLOCK Serial No. 75/471,846.*

While Barnhardt's family of ULTRA marks may not be considered "famous" nationwide, it is certainly well-known in the nonwovens industry. Not only is it well-known that Barnhardt owns a family of ULTRA prefixed marks, but also the USPTO records are available to the public and can be viewed by anyone, including Wildwood, when determining what mark to adopt in connection with its products.

Barnhardt developed a family of ULTRA prefixed marks in the cotton nonwovens industry almost twenty years ago. There would be a strong likelihood of confusion between Barnhardt's ULTRA marks and almost any other ULTRA prefixed mark in the cotton nonwovens industry. In this case, the mark is exactly the same as Barnhardt's ULTRA-CLEAN mark. Even the federal registration for the ULTRAWHITE mark for use in connection with cotton should have deterred Wildwood, or any one else in the very narrow nonwovens industry, from developing a ULTRA prefixed mark. This factor weighs heavily in favor of finding a likelihood of confusion.

**6. The number and nature of similar marks in use on similar goods.**

Wildwood has proffered no testimony deposition, nor filed any other evidence in support of an allegation of similar marks on similar goods. Accordingly, given the record is devoid of

any evidence relating to third party uses or registrations of marks that are the same as or similar to Barnhardt's mark, the lack of evidence of third party marks does add support to Barnhardt's claim that its ULTRA-CLEAN mark is strong. *Schering-Plough Healthcare Products, Inc. v. Ing-jing Huang*, 84 U.S.P.Q.2d (BNA) 1323, 1328 (T.T.A.B. 2007). The stronger a mark is, the greater the scope of protection that mark is given and the greater the likelihood that a similar mark will create confusion. See *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966,973 (11<sup>th</sup> Cir. 1983).

Barnhardt is aware of no other use of the term ULTRA-CLEAN or any other ULTRA prefixed marks in the cotton nonwovens industry other than Wildwood's ULTRACLEAN mark. On the other hand, Barnhardt has for several decades and is currently using other ULTRA prefixed marks on similar goods. Barnhardt's rights in the ULTRA-CLEAN mark and the other ULTRA prefixed marks are strong and this factor also weighs in favor of finding a likelihood of confusion.

**7. The nature and extent of any actual confusion.**

Proof of actual confusion is not necessary to establish likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983). Absent proof of demonstrating an "appreciable and continuous use" of the respective parties' marks for a significant period of time in the same markets, the mere assertion of a lack of any reported instances of actual confusion is not a meaningful factor. *Gillette Canada Inc. v. Ramir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (T.T.A.B. 1992). The prior art user should not be penalized because a registrant or applicant has not made widespread and prominent use of the mark. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2<sup>nd</sup> Cir. 1986). The Board has consistently recognized that evidence of actual confusion is notoriously difficult to come by and,

in any event, such evidence is not necessary to establish a likelihood of confusion. *Block Drug v. Ben-Met, Inc.*, 17 U.S.P.Q.2d (BNA) 1315, 1318 (T.T.A.B. 1989). Thus, even though Barnhardt does not yet know of any instances of actual confusion, this lack of knowledge does not diminish the strong likelihood that such actual confusion will occur or has already occurred.

**9. The variety of goods on which a mark is or is not used.**

Both Barnhardt and Wildwood are using the ULTRA-CLEAN and ULTRACLEAN marks on only one type of product. Both Barnhardt and Wildwood use their respective marks on cotton products that are used in the same end products. *Barnhardt Dep.* 23:1-12; *Gary Dep.* 30:5-12.

However, Barnhardt does have a family of ULTRA prefixed marks that are all currently or were in the past used on various cotton products. *Barnhardt Dep.* 7:7-22; 8:1-25; 9:1-6. Consequently, the likelihood of confusion or mistake among consumers is high given the limited but nearly identical goods.

**10. The market interface between the applicant and the owner of a prior mark.**

Barnhardt and Wildwood attend the same trade shows and advertise in the same industry publications. *Gary Dep.* 26:1-25; 30:1-12. The market is very narrow and the industry is extremely close-knit. *Barnhardt Dep.* 6:18-25. Barnhardt and Wildwood work with the same nonprofit industry organizations and have even worked together on new products and processes. *Gary Dep.* 30: 3-25; 31:1-25; 32:1-6. *Barnhardt Dep.* 9:23-25; 10:1-10. In total, the market interaction between Barnhardt and Wildwood as competitors in the same very narrow industry heavily favors a finding of likelihood of confusion when using nearly identical marks on nearly identical goods.

**11. The extent to which applicant has a right to exclude others from use of its mark on its goods.**

Barnhardt has a right to exclude others from use of the mark ULTRA-CLEAN, or any other confusingly similar marks, based on its continuous use in commerce since 2006.

Wildwood has not acquired rights in the ULTRACLEAN mark. Its use of ULTRACLEAN is an infringement upon the good will and trademark rights of Barnhardt in its ULTRA-CLEAN mark.

**13. Any other established fact probative of the effect of use.**

There are several other facts that the Board should consider in this case in determining whether Wildwood's mark should be canceled. First, there is a strong possibility that Wildwood had knowledge of Barnhardt's use of the ULTRA-CLEAN mark before adopting and using it. *Barnhardt Dep. 20: 21-25; 21:1-8*. Barnhardt has no concrete proof of Wildwood's intent or knowledge but given the close-knit nature of the nonwovens industry and the past dealings between Barnhardt and Wildwood, it is more likely than not that Wildwood was aware of Barnhardt's ULTRA-CLEAN mark before adopting and using the ULTRACLEAN mark.

Even if Wildwood did not have direct knowledge of Barnhardt's ULTRA-CLEAN mark, the other ULTRA marks, both active and inactive, are public records and available for review by anybody. Further, given the relationship between Barnhardt and Wildwood and the small size of the nonwovens industry, it is difficult to imagine that Wildwood did not at least have knowledge of Barnhardt's other ULTRA prefixed marks.

Also, the trademark examining attorney found confusion likely when examining Barnhardt's application Serial No. 85/072,021 for the ULTRA-CLEAN mark. In the refusal, the Examiner stated "[h]ere the marks are identical in everyway." Barnhardt agrees. Confusion is likely for ULTRA-CLEAN and ULTRACLEAN both for cotton in International Class 022.

In addition to these probative facts, the law requires that all doubts concerning confusion should be resolved in favor of Barnhardt as the senior user. *In re Hyper Shoppes, Inc.*, 837 F.2d 463, 464-65 (Fed. Cir. 1988). The newcomer “has the opportunity of avoiding confusion, and it is charged with the obligation to do so.” *In re Shell Oil Co.*, 992 F.2d 1204, 1209 (Fed. Cir. 1993). The ULTRA-CLEAN mark has been used in commerce since early 2006 and years before Wildwood filed its trademark application or began offering its goods under the ULTRACLEAN mark.

The law is well-settled that any doubt as to likelihood of confusion should be resolved in favor of the senior user. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683,681 (C.C.P.A. 1977) (resolution of doubt rule is “too well-settled as an axiom of trademark law to require citation of precedent.”). In the present case, any doubt concerning likelihood of confusion should be resolved in favor of Barnhardt, the senior user. *Kenny Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. Cert. Denied, 113 SCt. 181 (1992).


### **Conclusion**

Cancellation is appropriate where Petitioner has priority of rights and is likely to be damaged by another’s registration. Barnhardt has priority of use of a nearly identical mark on very similar products. The channels of trade are the exact same, the target and actual customers are the same. Under the *duPont* analysis, confusion is very likely. For these and the reasons set out above, Barnhardt respectfully requests that the Board grant its Petition to Cancel.

This the 20<sup>th</sup> day of April, 2012.

Respectfully submitted,

**SHUMAKER, LOOP & KENDRICK, LLP**

A handwritten signature in cursive script, reading "Kathryn A. Gromlovits", written over a horizontal line.

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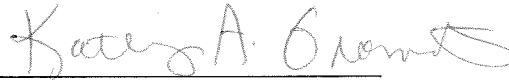
**CERTIFICATE OF SERVICE**

I hereby certify that a duplicate original of PETITIONER'S TRIAL BRIEF was served upon the Registrant by delivering a copy thereof by email to the following attorney of record:

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This the 20<sup>th</sup> day of April, 2012.

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